

REMARKS

Claims 1 and 3-20 remain pending in the application. Favorable reconsideration is respectfully requested in view of the following remarks.

As an initial matter, it is respectfully asserted that the finality of the present Action is improper because a new ground of rejection has been introduced that was neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR §1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP §706.07(a), page 700-74 (Rev. 2, May 2004). The Office Action alleges that Applicant's amendment necessitated the new ground(s) of rejection, but this is not believed to be the case. Rather, the amendments were clarifying in nature, and merely used different wording to define aspects that were already either expressly or inherently defined by the earlier claims. In one aspect, a number of claims were amended to even more strongly emphasize that "the mobile communications terminal" is performing the stated actions. The Office's examination prior to these amendments has certainly understood this, since the various references relied upon all involve a mobile communications terminal performing various actions.

Remaining amendments were made to more strongly emphasize that various data items were stored "earlier" at the storage location. However, this aspect had already been variously defined in the claims. For example, claim 8 had previously recited, "wherein the at least one data item stored at the storage location accessible over the mobile communications network was *earlier* stored at the storage location" (Emphasis added.)

For at least the foregoing reasons, it is believed that no new issues were raised by Applicant's amendments, and that the amendments, therefore, did not necessitate the new grounds of rejection. Accordingly, it is respectfully requested that the finality of the present Office Action be withdrawn.

Claims 1-4 [sic: "1, 3-4" because claim 2 was earlier canceled], 6, 15 and 16 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kraft (US-6,424,829) in view of Alanara (US-6,064,880A). This rejection is respectfully traversed.

Independent claims 1, 3-4, and 6 each define, in some manner, a method of storing information from a mobile communications terminal, which method includes determining a storage location from a plurality of storage locations that includes at least one storage location in the terminal and at least one storage location accessible over a mobile

communications network, and then the mobile terminal storing the information to a storage location accessible over a mobile communications network for its own later retrieval from that storage location.

In the remarks presented in Applicant's several previously filed Amendments, it was explained that Kraft merely discloses folders which store information within a communication terminal. Nothing in Kraft shows, teaches or suggests at least one storage location accessible over a mobile communication network as defined by Applicant's claims and including this as a possibility along with storage locations physically located within the communication terminal.

The Office acknowledges these shortcomings of Kraft, and now relies on Alanara as making up for the deficiencies. This reliance is unfounded because Alanara merely discloses a mobile terminal being able to *backup* data that is *already stored* in its internal memory to a storage location in the network. (See column 5, lines 1-19.) Later, this data can be retrieved from the storage location in the network and restored to the memory in the mobile terminal (see column 5, line 47 through column 6, line 10) in the event that the data is lost or corrupted. (See column 1, lines 43-47.) Nowhere does Alanara describe “determining a storage location from a plurality of storage locations ..., the plurality of storage locations including at least one storage location in said terminal and at least one storage location accessible over a mobile communications network.” (Emphasis added.)

Thus, even if one were to combine the teachings of Alanara with those of Kraft, as now suggested by the Office, the combination would provide a mobile terminal that can store data in an internal memory, and that can backup this data to a storage location in the network. There is nothing in either reference to even suggest choosing to store the data *either* in the mobile terminal *or* in the network storage location, as now variously defined by Applicant's claims.

In support of its rejection, the Office relies on Alanara at column 1, lines 44-63; column 5, lines 1-19; and column 5, line 47 through column 6, line 10. However, as explained above, these and other parts of Alanara merely disclose using a network storage location to backup data that is *also* stored in the mobile terminal. This precludes “determining a storage location ...” – that is, determining one storage location selected from a plurality of storage locations including a network storage location and a storage location in the mobile terminal.

Elsewhere, Alanara describes using the network storage location as a place for holding data until it can be downloaded into a different mobile terminal. (See, e.g., Alanara at column 6, lines 11-15.) This aspect of Alanara cannot support the Office's rejection because it is contrary to that aspect of Applicant's claims that defines "storing the information to said storage location for later retrieval by *the* mobile communications terminal" (i.e., the same terminal that stored the information).

Thus, it is believed that no combination of Kraft and Alanara shows, teaches or suggests a method of storing information for a mobile communication terminal which method includes "the mobile communications terminal determining a storage location from a plurality of storage locations ..., the plurality of storage locations including at least one storage location in said terminal and at least one storage location accessible over a mobile communications network; and the mobile communications terminal storing the information to said storage location for later retrieval by the mobile communications terminal", as variously defined by Applicant's independent claims. Consequently, no combination of Kraft with Alanara can support a *prima facie* case of obviousness because such a combination would still fail to include all of the features defined by Applicant's claims. (It is well established that one of the necessary criteria for supporting a *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all the claim limitations.)

For at least the foregoing reasons, independent claims 1, 3, 4, and 6 are believed to be patentably distinguishable over any combination of Kraft and Alanara. Claims 15 and 16 depend from claim 1, and are therefore patentable for at least the same reasons. Accordingly, it is respectfully requested that the rejection of claims 1, 3-4, 6, 15 and 16 under 35 U.S.C. §103(a) be withdrawn.

Claims 5 and 7 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kraft in view of Alanara, and further in view of Jeon (US-6,205,331). This rejection is respectfully traversed.

Like the claims discussed above, independent claim 7 defines "presenting to a user a list of available storage locations, the available storage locations including at least one storage location in said terminal and at least one storage location accessible over a mobile communications network" and then storing the information at one or the other of the locations. Claim 5 depends from independent claim 4 (discussed above), and therefore also defines a comparable feature.

As explained above, neither Kraft nor Alanara disclose or suggest any capability of the mobile communications terminal to selectively store information either in a mobile terminal or in a network storage location. Consequently, no combination of Kraft with Alanara can support a *prima facie* case of obviousness because such a combination would still fail to include all of the features defined by Applicant's claims.

Jeon fails to make up for the deficiencies of Kraft and Alanara. As explained in Applicant's previously-filed amendment, Jeon merely discloses accessing a second memory to determine if storage is available and if not, determining if storage space is available in a first memory. Nothing in Jeon discloses or suggests a mobile communications terminal storing information in a storage location accessible over a mobile communications network, wherein that information is available for later retrieval by a user of the mobile communications terminal. Thus, no combination of Kraft with Alanara and Jeon will include this feature.

It was further explained in the previously filed Amendment that another deficiency of Jeon is its failure to disclose or suggest storing information in a first preferred location selected by a user and storing information in a second preferred storage location selected by a user as defined by each of claims 5 and 7. Once again, the most-recent Office Action does not dispute this failing, and yet maintains the rejection of these claims for reasons unknown to the Applicant.

For at least the foregoing reasons, each of claims 5 and 7 is believed to be patentably distinguishable over any combination of Kraft, Alanara, and Jeon. Accordingly, it is respectfully requested that the rejection of these claims under 35 U.S.C. §103(a) be withdrawn.

Claims 8, 10, 11, 13, 17 and 18 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Alanara in view of Smith et al. (US-6,333,973). This rejection is respectfully traversed.

Independent claim 8 defines "the mobile communications terminal presenting to a user a list of available data items, the available data items including at least one data item stored at a storage location in said terminal and at least one data item stored earlier at a storage location accessible over a mobile communications network." Claim 8 also defines that "the at least one data item stored earlier at the storage location accessible over the mobile communications network was earlier stored at the storage location accessible over the mobile

communications network by the mobile communications terminal." (Emphasis added.) Thus, like the claims discussed earlier, claim 8 is directed to a mobile communications terminal storing information at a location accessible over the mobile communications network, and later being able to retrieve that same information from the location accessible over the mobile communications network. Claims 10-11 depend from claim 8, and claims 17-18 depend from claim 1, and therefore similarly define this feature. Independent claim 13 also defines comparable features in its recitation of "the mobile communications terminal presenting to a user a list of available data items, the available data items including at least one data item stored earlier by the mobile communications terminal, and at least one data item stored by a central source and accessible by multiple users, wherein the at least one data item stored earlier by the mobile communications terminal is stored at a storage location accessible over the mobile communications network." (Emphasis added.)

The Office acknowledges that Alanara fails to disclose at least the feature wherein the user is presented with a list of available data items, but relies on Smith et al. as making up for this deficiency. This reliance is unfounded, however, because the Smith et al. patent merely discloses voicemail servers, e-mail servers and fax mail servers that store information from another source for a user. Nothing in Smith et al. shows, teaches or suggests a method of storing information from a mobile communication terminal for later retrieval by that mobile terminal. Therefore, no combination of Smith et al. with Alanara will include the "the mobile communications terminal presenting to a user a list of available data items, *the available data items including* at least one data item stored at a storage location in said terminal *and at least one data item stored earlier at a storage location accessible over a mobile communications network*, wherein the at least one data item stored earlier at the storage location accessible over the mobile communications network *was earlier stored* at the storage location accessible over the mobile communications network *by the mobile communications terminal*" as defined by claim 8. (Emphasis added.) Thus, the combination of Alanara with Smith et al. does not support a *prima facie* case of obviousness.

For at least the foregoing reasons, claims 8, 10-11, 13, and 17-18 are believed to be patentably distinguishable over any combination of Alanara with Smith et al. It is therefore respectfully requested that the rejection of these claims under 35 U.S.C. §103(a) be withdrawn.

Claims 9, 12, and 14 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Alanara in view of Smith et al. and further in view of Wicks et al. (US-5,796,394). This rejection is respectfully traversed.

Claims 9 and 12 depend from independent claim 8, and claim 14 depends from claim 13. Consequently, these dependent claims inherit the various features discussed above with respect to their base claims.

Claims 9, 12, and 14 are therefore patentably distinguishable over any combination of Alanara with Smith et al. for reasons similar to those presented above. The Wicks et al. patent fails to make up for the deficiencies of these other documents at least because it neither describes nor suggests the feature discussed above. Consequently, no combination of Alanara, Smith et al., and Wicks et al. will include all of the features defined by claims 9, 12, and 14.

For at least the foregoing reasons, claims 9, 12, and 14 are believed to be patentably distinguishable over any combination of Alanara, Smith et al., and Wicks et al. Accordingly, it is respectfully requested that the rejection of these claims under 35 U.S.C. §103(a) be withdrawn.

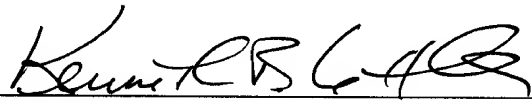
Claims 19 and 20 each stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kraft in view of Alanara and further in view of "what was well known at the time of the invention." These rejections are respectfully traversed.

Claims 19 and 20 depend from independent claims 1 and 8, respectively, and are therefore patentable for at least the reasons set forth above with respect to those base claims.

The application is believed to be in condition for allowance. Prompt notice of same is respectfully requested.

Respectfully submitted,
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